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UBER, NATHAN C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,956

Applicant(s)

PARK ET AL.

Examiner

NATHAN C. UBER

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 21 October 2009.
2. Claims 1, 4, 8-10, 13, 14, 18, 19 and 23-25 have been amended.
3. Claim 3 has been canceled.
4. Claims 1, 2 and 4-25 are currently pending and have been examined.

Specification

5. The substitute specification filed 21 October 2009 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: (1) the marked-up copy does not demonstrate changes/corrections to the original specification, but rather corrections made to the previously submitted specification which was denied entry. Additionally Applicant's corrections go beyond merely grammatical corrections; Applicant (2) replaces words with words that have different meanings and Applicant (3) adds limitations that narrow the scope of the disclosure. Examiner notes that this is the second time Applicant's substitute specification is being denied entry because Applicant made impermissible changes to the original disclosure.
6. With regard to (1) above, because the marked-up copy is not truly a marked-up copy of the original, Examiner cannot guarantee that the list of reasons the substitute specification is impermissible is exhaustive. Applicant is encouraged, if Applicant intends to submit another substitute specification, to provide a marked-up copy of the original specification not marked-up copies of previously un-entered substitute specifications. This will aid in the pursuit of more expedient and compact prosecution.
7. With regard to (2) above, below is a table of words that were replaced in the substitute specification with new words that are not synonyms of the previous terminology and/or were replaced inconsistently. Such substitutions are not necessary for correcting grammatical and idiomatic issues and for that reason alone the amendments are impermissible. Further because

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the original and replacement words are not synonyms the meaning of the disclosure changes as a result of the substitution and this affects the scope of the original disclosure. The table below identifies the words that were substituted and the *first* location where a substitution occurred in the substitute specification (many of these same substitutions occur throughout the specification). The table also demonstrates the inconsistent use/replacement of terms noting where they were replaced/retained in the substitute specification.

Original Word	Amendment	Location in Marked-up Copy
Grasping	Evaluating	page 1, line 6
Judging	Determining	page 1, line 14
Grasping	Determining	page 5, line 7
Investigate	Determining	page 10, lines 15 and 16
Means	Defines	page 12, lines 6 and 7
Understanding	Analyzing	page 13, line 2
Understands	Understands	page 15, line 25
Means	Represents	page 27, line 12
Means	Means	page 29, line 7
Judge	Found	page 33, line 17
Making	Forming	page 35, lines 9 and 10

8. As noted above, many of the substituted terms are not synonyms of the word they are replacing. For example grasping is defined as appreciation, understanding of the nature or meaning or quality or magnitude of something. However grasping was replaced in the substitute specification inconsistently with evaluating and determining. Evaluate has a variety of definitions, the most applicable being: to perform instructions written in a programming language, draw conclusions from examining, make a judgment based on criteria, determining the value of. Determining is defined more narrowly: to ascertain definitely. Neither evaluating nor determining are synonymous with 'grasping,' therefore the substitution of the words changes the original

disclosure. Likewise judging means form a critical opinion of something and investigate means conduct an inquiry of something. These terms are also not synonymous with determine. Applicant also inconsistently replaces the word means which has various meanings that are relevant to the technology and the patent law (means as in defining, means as in structure capable of, etcetera). The amendment on page 12 changes the sentence from one that further defines the word type (i.e. 'the type at the step of 220 means a set of...') to a sentence in which 'type' is no longer defined, but rather is itself defining predetermined input patterns. This difference is subtle, but formerly the specification indicated that the events are classified by type and the type meant/indicated predetermined event input patterns. Now the type maybe interpreted broader, now the type defines predetermined event input patters, but may also perform other tasks and embody other characteristics. Here Applicant's amendment removes a narrow definition and replaces it with a broader one.

9. With regard to (3) above, at least twice Applicant's amendments further limit the specification and neither amendment is necessary to correct grammatical or idiomatic English issues. See page 12, lines 11-12, the amendment states '...an event that can be accurately considered...' and see page 26, line 4, the previous language 'in other form that is not described in the above embodiment' is removed, limiting the interpretation of the figure that the paragraph is describing. These changes are neither consistent with the original disclosure nor necessary to correct grammatical or idiomatic English issues.
10. In light of these issues (and Examiner reiterates that the list of issues (1-3) indicated above may not be an exhaustive list of issues, but rather a list of examples), Examiner objects to the substitute specification because it adds new matter to the disclosure and therefore the new specification will not be entered. Further Examiner continues to struggle with Applicant's broad terminology in the claims especially in light of Applicant's inconsistent use of the same terminology in the specification and the lack of explicit definitions in the specification.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a. The claims are amended to include 'the history data comprises the number of times the predetermined event is inputted by the user and a period of time over which the predetermined event is inputted by the user.' Applicant argues that this limitation is supported on page 11, lines 14-16 of the 'original disclosure' (see page 16 of Applicant's remarks). The referenced portion of the 'original disclosure' is reproduced herein: '...predetermined reference as a result of analysis of the recorded history information after such event is classified according to its type. According to an embodiment of the present invention, there may be a plurality of events recorded as the interested field of the user...' As demonstrated, the referenced section of the 'original disclosure' does not support Applicant's amendment. Throughout the specification 'history data' is never defined/described/limited as in the present version of the claims. The disclosure notes on page 9 that 'history information' may include similar information to the information added by Applicant's amendment, however the terms 'history data' and 'history information' are consistently used independently of each other in the specification indicating that they are describing different data/information albeit both types of data/information of a historical nature.

b. The claims are amended to include 'the type information represents an effective period that is predetermined for the keyword.' Applicant argues that this limitation is supported on page 17, lines 15-19 of the 'original disclosure' (see page 16 of Applicant's remarks). The referenced portion of the 'original disclosure' is reproduced herein: '...for the number of issues of an

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advertisement cookie or a file for a user PC number for which the advertisement cookie is issued, is consistently updated according to predetermined keyword data whenever the advertisement cookie in which the predetermined keyword data is included, is issued. FIG. 5 is a structural block diagram showing another example of the system in...'. As demonstrated, the referenced section of the 'original disclosure' does not support Applicant's amendment. Although 'type information' is not used in the referenced portion of the specification, it is used elsewhere. However, 'type information' is merely referred to and never defined or described. Applicant's amendment describing/defining the 'type information' is new matter as it is not supported by the 'original disclosure.'

c. The claims are amended to include 'the predetermined reference information comprises several conditions including a number of times an event is inputted, a frequency of the event generation, recentness of the event generation, and a predetermined priority associated with the event.' Applicant argues that this limitation is supported on page 12, lines 5-8 of the 'original disclosure' (see page 16 of Applicant's remarks). The referenced portion of the 'original disclosure' is reproduced herein: '...and judge the interested field of the user according to the described predetermined reference. According to the present embodiment, there is a strong point of understanding the interested field by monitoring all cases where a user makes use of a plurality of Internet services. For example, not only when a user inputs a keyword at the...' As demonstrated, the referenced section of the 'original disclosure' does not support Applicant's amendment. The term 'predetermined reference information' only appears twice in the original disclosure, both times without a definition. Applicant's amendments are not supported by the original disclosure. Because the newly added limitations are unsupported by the original disclosure, contrary to Applicant's arguments, the new limitations constitute impermissible new matter.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1, 18, 23, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims newly recite *recording a keyword as history data that corresponds to the received predetermined event, from the user, wherein the history comprises the number of time the predetermined event is inputted by the user and a period of time over which the predetermined event is inputted by the user*. The claim is indefinite because the claims discloses that a *keyword* is recorded as history data indicating that history data is defined at least as a recorded keyword, however the claim continues and defines *history data* as comprising other information to the exclusion of recorded keywords. Further the method step calls for recording only a keyword and not the other items that apparently additionally/alternatively comprise history data indicating that that some steps may be missing from the claims. These deficiencies result in a vague and indefinite claim because it presents conflicting definitions of *history data* and because the relationship of the two disclosed *history data* elements to the step of *recording* is not clearly stated.
15. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims newly recite *searching for advertisement information... when there is no advertisement information*. Usually when searching a database, the searcher is only apprised of the content of the database at the completion of the search, thus this limitation is indefinite because it only permits a search when the items to be searched are known to be absent without indicating how the searcher might know, before completing the search, whether the items are absent.

Claim Rejections - 35 USC § 101

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The *computer-readable medium* of Claim 18 is not a process, machine, manufacture, or composition of matter, or any improvement thereof. Rather the "media may be a transmission medium such as... carrier wave transmitting signals" (see page 28, lines 16-18 of the original specification). Replacing the preamble with "a computer-executable program product tangibly embodied on a computer readable medium" wherein the computer readable medium is limited to physical storage media is a suggestion for how to bring this claim into compliance with 35 U.S.C. 101. Signals are *per se* not statutory subject matter, therefore the claim may neither be directed to a signal nor interpretable (under §2111) as being directed to a signal.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
19. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
20. Claims 1-7, 18-20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02107030 A1) alone.

Claims 1, 18, 23, 24 and 25:

Nam, as shown, discloses the following limitations:

- *maintaining a keyword database for recording multiple keywords, type information of each keyword, predetermined reference information that corresponds to the type information, and advertisement list information that corresponds to each keyword, in which the advertisement list information includes a number of advertisement files that include each keyword (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),*
- *receiving a predetermined event from a user, wherein the predetermined event is an action taken by the user while utilizing the internet (see at least Figure 5, Item 501, see also at least page 11, lines 5-14, input server address, input search keywords),*
- *recording a keyword as history data that corresponds to the received predetermined event, from the user, wherein the history comprises the number of time the predetermined event is inputted by the user and a period of time over which the predetermined event is inputted by the user (see at least page 11, lines 10-12, the input is stored in a table and previously stored information based on the keyword is retrieved and stored in the same table),*
- *searching for the type information of the keyword by referring to the keyword database, wherein the type information represents an effective period that is predetermined for the keyword (see at least page 11, lines 5-12, information about the characteristics of the page or the inputted keyword are transmitted to the advertising server, the advertisement server gathers this information and stores it in the database; this data is later retrieved/searched upon input of the keyword to generate the advertisement table; the broadest reasonable interpretation of type information represents an effective period permits an interpretation that type information can be the same as the keyword because*

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a keyword inherently represents its own characteristics; see also at least page 16, lines 20-21, predetermined exposure periods),

- *searching for the predetermined reference information that corresponds to the type information of the keyword, wherein the predetermined reference information comprises several conditions including a number of times an event is inputted, a frequency of the event generation, recentness of the event generation, and a predetermined priority associated with the event* (see at least page 16, lines 9-12, advertisements may be classified according to directories requested by the advertiser (i.e. predetermined) and the ads are displayed after searching the directories using the keyword; Examiner notes that the reference to random display in this section assumes that more than one ad exists in the same subdirectory),
- *determining whether the keyword is an interested field of the user in view of the predetermined reference information* (see at least Table 1, this invention pre-stores information about each user including users fields of interest; see also at least page 10, lines 13-14, advertisements may be presented based on both the user's field of interest and the characteristics of the page; Examiner notes, based on the above disclosure that characteristics of the page are include keywords derived from the page as well as characteristics associated with keywords; see further at least page 11, lines 5-15, the site that the user navigates to or the search input of the user are retrieved in the form of keywords, these keywords are assumed to be an *interested field of the user* since the user actively entered them),
- *generating an advertisement file including the keyword that is determined to be the interested field of the user* (see at least page 11, lines 10-11, the advertisement table is generated based on the information and the input),

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- *updating a number of advertisement files in the advertisement list information stored in the keyword database* (see at least page 6, liens 13-14, the advertisement server stores the advertisement tables, here the advertisement file is the advertisement table; see also at least page 15, lines 6-11, searching a cookie (i.e. a cookie that is pre-stored) corresponding to the keyword, here the advertisement file is a cookie),
- *generating advertisement information including the keyword and the advertisement list information updated with the number of advertisement files* (see at page 15, lines 23-25, the click information is stored in the cookie; see also at least page 16, lines 16-24, further generation and reference to advertisement information; see also at least page 17, lines 27-29, advertisement statistics can be collected according to an advertising site; Examiner notes that, as demonstrated above, the site that a user navigates to may be used as the keyword to look-up relevant advertising, thus advertisement statistics may be keyed to keywords),

Examiner notes that several of the above limitations are directed to the composition of data. The composition of data is considered non-functional descriptive material when there is no functional relationship among the disclosed data descriptions evident in the claim. Concerning the *history data*, *type information* and *predetermined reference information* above, the claims only detail the composition of this data and fail to disclose the functional significance of the described content. For example, we know that history data includes a keyword and the keyword has is related to the function of the method because it is recorded by the method. With respect to type information however, the claim only indicates that this information is searched, what the type information represents has no effect on the functionality of the search step. Although it is not always true that limitations that serve to describe data are non-functional, in the above claims for

the above three indicated limitations, it is the case that the limitations are non-functional descriptive material and they have no effect on the scope of the claim.

Although the reference teaches each limitation as shown in the rejection above, the reference discloses many elements with reference to several separate embodiments. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the various elements among the disclosed embodiments since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the predetermined event is one among a keyword inputted at a search window of an Internet search engine by the user, a web page address inputted at an address window of a web browser by the user, and a hypertext markup language link selected on the web browser by the user (see at least page 3, line 12, inputting a website address).*

Claim 4:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the predetermined reference information includes a number of times the predetermined event is inputted from the user during the predetermined effective period (see at least page 16, line 20-21).*

Claim 5:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement file is a cookie file (see at least page 12, line 20-21).*

Claim 6:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement file includes at least one of a terminal number (PC ID) of the user, an identifying symbol of the user, expiration data of the advertisement file (see at least page 17, lines 5-8, identifying information of the user is stored).*

Claim 7:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement information additionally includes a number of impressions of a web page that corresponds to the keyword (see at least page 16, line 20-21).*

Claim 19:

Nam, as shown, discloses the following limitations:

- *a keyword database recording multiple keywords, type information of each keyword, predetermined reference information that corresponds to the type information, advertisement list information that corresponds to each keyword, in which the advertisement list information includes a number of advertisement files that include each keyword, wherein the type information represents an effective period that is predetermined for the keyword and the predetermined reference information comprises several conditions including a number of times an event is inputted, a frequency of the event generation, recentness of the event generation, and a predetermined priority associated with the event (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key"*

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rather than keyword; the broadest reasonable interpretation of *type information represents an effective period* permits an interpretation that type information can be the same as the keyword because a keyword inherently represents its own characteristics; see also at least page 16, lines 20-21, predetermined exposure periods),

- *a communication part receiving a predetermined event from a user, wherein the predetermined event is an action taken by the user while utilizing the internet* (see at least Figure 5, Item 501, see also at least page 11, lines 5-14, input server address, input search keywords),
- *a processing part recording a keyword as history data that corresponds to the received predetermined event from the user* (see at least page 11, lines 10-12, the input is stored in a table and previously stored information based on the keyword is retrieved and stored in the same table),
- *searching for the type information of the keyword and the predetermined reference information that corresponds to the type information of the keyword by referring to the keyword database* (see at least page 11, lines 5-12, information about the characteristics of the page or the inputted keyword are transmitted to the advertising server, the advertisement server gathers this information and stores it in the database; this data is later retrieved/searched upon input of the keyword to generate the advertisement table; see also at least page 16, lines 9-12, advertisements may be classified according to directories requested by the advertiser (i.e. predetermined) and the ads are displayed after searching the directories using the keyword; Examiner notes that the reference to random display in this section assumes that more than one ad exists in the same subdirectory),
- *determining whether the keyword is an interested field of the user according to the predetermined reference information and type information of the*

*keyword searched in the keyword database, wherein the history data comprises the number of times the predetermined event is inputted by the user and a period of time over which the predetermined event is inputted by the user (see at least Table 1, this invention pre-stores information about each user including users fields of interest; see also at least page 10, lines 13-14, advertisements may be presented based on both the user's field of interest and the characteristics of the page; Examiner notes, based on the above disclosure that characteristics of the page are include keywords derived from the page as well as characteristics associated with keywords; see further at least page 11, lines 5-15, the site that the user navigates to or the search input of the user are retrieved in the form of keywords, these keywords are assumed to be an *interested field of the user* since the user actively entered them),*

- an advertisement file preparing part extracting the keyword determined to be the interested field of the user and generating an advertisement file including the extracted keyword, in which the advertisement file includes at least one of a user's terminal number (PC ID), an identifying symbol of the user, and expiration date information of the advertisement file (see at least page 11, lines 10-11, the advertisement table is generated based on the information and the input, see also at least page 17, lines 5-8, identifying information of the user is stored),*
- an advertisement information generating part updating a number of advertisement files in the advertisement list information stored in the keyword database and generating advertisement information including the keyword and the advertisement list information updated with the number of advertisement files (see at least page 6, liens 13-14, the advertisement server stores the advertisement tables, here the advertisement file is the*

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advertisement table; see also at least page 15, lines 6-11, searching a cookie (i.e. a cookie that is pre-stored) corresponding to the keyword, here the advertisement file is a cookie),

- *an advertisement database storing multiple keywords and multiple advertisement data that corresponds to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *an advertisement transmitting part processing the advertisement data that corresponds to the keyword included in the advertisement file by referring to the advertisement database, and providing the advertisement data that is processed to a web browser of the user* (see at least page 12, lines 26-28, the searched ad is sent to user display device),
- *a storing part storing history information with respect to the providing of the advertisement data to the user* (see at least page 12, line 30 continuing to page 13, line 1, whether the ad loads properly is confirmed and recorded),
- *an analyzing part providing predetermined feedback information to a sponsor who has registered the advertisement data, according to the history information* (see at least page 17, lines 27-29, statistics of ad information may be collected by advertiser or advertiser site on a regular basis).

Examiner notes that several of the above limitations are directed to the composition of data. The composition of data is considered non-functional descriptive material when there is no functional relationship among the disclosed data descriptions evident in the claim. Concerning the *history data*, *type information* and *predetermined reference information* above, the claim only details the composition of this data and fails to disclose the functional significance of the described content. For example, we know that system comprises a central server and an advertisement server, each comprising storage, databases and several 'parts' that receive, record and send data. However none of the

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structures are limited in scope by the newly added data descriptions. Although it is not always true that limitations that serve to describe data are non-functional, in the above claims for the above three indicated limitations, it is the case that the limitations are non-functional descriptive material and they have no effect on the scope of the claim.

Although the reference teaches each limitation as shown in the rejection above, the reference discloses many elements with reference to several separate embodiments. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the various elements among the disclosed embodiments since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 20:

Nam discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitation:

- *the advertisement list information additionally includes a number of impressions of a web page that corresponds to the keyword* (see at least page 16, line 20-21).

21. Claims 8-17, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nam et al. (WO 02107030 A1) in view of Cheung et al. (US 7,043,471 B2).

Claim 8:

Nam, as shown, discloses the following limitations:

- *maintaining a keyword database for storing multiple keywords and advertisement information according to the keywords* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),

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- *receiving a first advertisement request that includes an advertisement keyword from a first sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database (see at least page 13, line 20-21, see also page 11, lines 5-25, advertising corresponds to the keywords, see also page 8, advertisement and corresponding key),*
- *the advertisement request is a request for the advertisement information about the advertisement keyword so that the first sponsor can determine whether or not to purchase the advertisement keyword (see at least page 13, lines 20-23, advertisers request advertisement categorization information; Examiner notes that the limitation so that the first sponsor can... is an intended user limitation and does not effect the scope of the claim limitation which is directed to receiving a request, the claim does not positively recite the determination step, the purpose for the receipt of information and the possible uses of the information may vary without impacting the method which is directed only to receiving the data; Examiner further notes that Cheung also discloses this limitation, see below),*
- *searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database (see at least page 3, line 26, see also page 11, lines 5-25, advertising corresponds to the keywords),*
- *when there is no advertisement information corresponding to the advertisement keyword in the keyword database, recording the received advertisement keyword (see at least Figure 1, items 118 and 119, the advertisement database stores ads and keywords and advertisement server stores tables that enable the invention to search the ad database and select and transmit the ads),*

- *recording, in a first advertisement database, the advertisement keyword and the first advertisement data from the first sponsor that corresponds to the advertisement keyword* (see at least Figure 1, items 118 and 119, the advertisement database stores ads and keywords and advertisement server stores tables that enable the invention to search the ad database and select and transmit the ads),

Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitations:

- *receiving a first advertisement request that includes an advertisement keyword from a first sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database* (see at least column 6, line 48-51, the advertiser associates the ad with the desired keywords, keywords may or may not be in use, ad is ranked based on relative price paid for the selected keyword(s),
- *the advertisement request is a request for the advertisement information about the advertisement keyword so that the first sponsor can determine whether or not to purchase the advertisement keyword* (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that the limitation *so that the first sponsor can...* is an intended user limitation and does not effect the scope of the claim limitation which is directed to receiving a request, the claim does not positively recite the determination step, the purpose for the receipt of information and the possible uses of the information may vary without impacting the method which is directed only to receiving the data),

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- *processing the advertisement information that corresponds to the advertisement keyword and providing the advertisement information corresponding to the advertisement keyword to a web browser of the first sponsor* (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that this prediction mechanism requires a determination of expected clicks based on previous data and keyword),
- *receiving a purchase response from the first sponsor, in which the purchase response includes first advertisement data of the first sponsor* (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),

Both Nam and Cheung disclose counting features:

- *incrementing a request counter value for the advertisement keyword in a predetermined storing means, wherein the request counter value is a number of times an advertisement keyword is requested by a sponsor* (see at least Nam page 16, lines 17-18; see at least Cheung column 6, lines 48-51, ad rank; see also at least Cheung column 8, lines 31-44, seniority),

Neither reference specifically discloses counting the specified data element in the above limitation, however, given the fact that the ability to program a computerized device to count similar information as demonstrated by both prior art references it would have been obvious to a person having ordinary skill in the art at the time the invention was made to additionally count sponsor requests since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature of Cheung with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 9:

The combination Nam/Cheung discloses the limitations as shown in the rejections above.

Further, Cheung, as shown, discloses the following limitations:

- *if a second advertisement request including the advertisement keyword is received from a second sponsor, increasing the request counter value for the advertisement keyword recorded in the storing means (see at least, column 8, lines 31-44, seniority, the second ad request for the same keyword will have a lower seniority than the first; however ad placement will still vary depending on the bid rank),*
- *determining whether the request counter value is greater than a predetermined value if the request counter value is greater than the predetermined value, recording, the advertisement keyword and advertisement information that corresponds to the advertisement keyword in the keyword database (see at least column 6, line 48-51, the advertiser associates the ad with the desired keywords, keywords may or may not be in use, ad is ranked based on relative price paid for the selected keyword/s),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because

Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 10:

The combination Nam/Cheung discloses the limitations as shown in the rejection above.

Further, Nam, as shown, discloses the following limitation:

- *wherein the the advertisement information includes at least one of information for a number of generated advertisement files, information for a number of impressions of a web page corresponding to the advertisement keyword, price information of the advertisement keyword (see at least page 16, line 20-21).*

Claim 11:

The combination Nam/Cheung discloses the limitations as shown in the rejection above.

Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitation:

- *the purchase response additionally includes payment information for a predetermined advertisement charge (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the

advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 12:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Nam does not specifically disclose the following limitation. However, Cheung, as shown, discloses the following limitation:

- *the advertisement request is performed in a manner of auction or bidding (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting),*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claims 13 and 14:

Nam, as shown, discloses the following limitations:

- *maintaining an advertisement database for storing multiple keywords and multiple advertisement data that correspond to the keywords (see at least page 8, line 10-12, a database that may be indexed by "key" – note that this patent uses the phrase "key word" and "key" rather than keyword),*

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- *receiving an access request from a user, wherein the access request includes an advertisement file stored in a user's terminal (see at least Figure 3, Item 304),*
- *extracting a keyword recorded in the advertisement file received (see at least page 3, line 21, the information stored in the cookie may include key words, see page 3, line 25),*
- *searching for the advertisement data that corresponds to the keyword by referring to the advertisement database when there is no advertisement information corresponding to the advertisement keyword in the keyword database, recording the received advertisement keyword and incrementing a request counter value for the advertisement keyword in a predetermined storing means, wherein the request counter value is a number of times an advertisement keyword is requested by a sponsor (see at least page 3, line 26; see also at least Figure 1, items 118 and 119, the advertisement database stores ads and keywords and advertisement server stores tables that enable the invention to search the ad database and select and transmit the ads; see also at least Nam page 16, lines 17-18; see also at least Cheung column 6, lines 48-51, ad rank; see also at least Cheung column 8, lines 31-44, seniority),*
- *processing the advertisement data corresponding to the keyword and providing the same to a web browser of the user (see at least page 3, line 26-27),*
- *maintaining a keyword database for storing multiple keywords and advertisement information according to the keywords (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),*

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- *receiving an advertisement request that includes an advertisement keyword from a sponsor, wherein the advertisement keyword corresponds to one of the multiple keywords stored in the keyword database (see at least page 13, line 20-21),*
- *the advertisement request is a request for the advertisement information about the advertisement keyword so that the first sponsor can determine whether or not to purchase the advertisement keyword (see at least page 13, lines 20-23, advertisers request advertisement categorization information; Examiner notes that the limitation so that the first sponsor can... is an intended user limitation and does not effect the scope of the claim limitation which is directed to receiving a request, the claim does not positively recite the determination step, the purpose for the receipt of information and the possible uses of the information may vary without impacting the method which is directed only to receiving the data; Examiner further notes that Cheung also discloses this limitation, see below),*
- *searching for the advertisement information that corresponds to the advertisement keyword by referring to the keyword database (see at least page 3, line 26),*
- *recording, in the advertisement database, the advertisement keyword and the advertisement data that corresponds to the advertisement keyword (see at least page 3, line 20).*

Nam does not specifically disclose the following limitations. However, Cheung, as shown, discloses the following limitations:

- *the advertisement request is a request for the advertisement information about the advertisement keyword so that the first sponsor can determine whether or not to purchase the advertisement keyword (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on*

the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that the limitation so *that the first sponsor can...* is an intended user limitation and does not effect the scope of the claim limitation which is directed to receiving a request, the claim does not positively recite the determination step, the purpose for the receipt of information and the possible uses of the information may vary without impacting the method which is directed only to receiving the data),

- *processing the advertisement information that corresponds to the advertisement keyword and providing the advertisement information corresponding to the advertisement keyword to a web browser of the first sponsor* (see at least column 23, lines 22-55, "project expenses" feature of this invention predicts based on the advertisement keyword the response that an advertiser can expect, i.e. the number of clicks, and predicts the cost of the advertising campaign for the advertiser based on a cost per click payment scheme; Examiner notes that this prediction mechanism requires a determination of expected clicks based on previous data and keyword),
- *receiving a purchase response from the first sponsor, in which the purchase response includes first advertisement data of the first* (see at least column 6, line 48-51, generally describing bidding for keywords in a search engine advertising setting and advertiser providing payment for the ad),
- *providing the user interface screen to a web browser of the user such that both the first advertisement data and the second advertisement data are provided to the user simultaneously* (see at least column 7, lines 7-11, displaying multiple ads to a user ranked by bid amount),

Neither reference specifically discloses counting the specified data element in the above limitation, however, given the fact that the ability to program a computerized device to count similar information as demonstrated by both prior art references it would have been obvious to a person having ordinary skill in the art at the time the invention was made to additionally count sponsor requests since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine a bidding feature with the advertising invention of Nam because Cheung discloses that a better way to control advertising costs while maximizing advertising exposure is needed and endorses bidding price strategies that allow the advertisers to set the appropriate price for an ad thereby alleviating the costly effects of an arbitrary pricing strategy. Examiner notes that although the Cheung invention is focused on alleviating costs further in the advertising chain, i.e. controlling click-through costs, the per ad/click costs/rates in the Cheung invention are initially derived from bidding.

Claim 14:

Nam, as shown, discloses the following limitations:

- *constructing a user interface screen by arranging the first advertisement data or the second advertisement data according to predetermined criteria (see at least page 3, line 26-27, see also at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),*

Claim 15:

The combination Nam/Cheung discloses the limitations as shown in the rejection above. Further, Nam, as shown, discloses the following limitations:

- *maintaining a second advertisement database for storing multiple second advertisement data that corresponds to a predetermined keyword* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *maintaining a third advertisement database for storing multiple third advertisement data* (see at least page 8, line 10-12, a database that may be indexed by "key" - note that this patent uses the phrase "key word" and "key" rather than keyword),
- *receiving a second keyword from the user* (see at least page 11 , lines 8-9),
- *searching for the second advertisement data that corresponds to the second keyword by referring to the second advertisement database* (see at least page 3, line 26),
- *searching for the third advertisement data by referring to the third advertisement database* (see at least page 3, line 26),
- *constructing a user interface screen by arranging the advertisement data, the second advertisement data, and the third advertisement data according to predetermined criteria* (see at least page 2, line 18, ads are displayed based on the ad table, i.e. the order),
- *providing the user interface screen to the web browser of the user reference* (see at least page 2, line 18, ads are displayed).

Claims 16 and 21:

The combination Nam/Cheung discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitations:

- *the second advertisement data is general keyword advertisement data, and a third advertisement data is general banner advertisement data* (see at least page 8, line 13, banner advertisement).

Claims 17 and 22:

The combination Nam/Cheung discloses the limitations as shown in the rejections above.

Further, Nam, as shown, discloses the following limitations:

- *providing predetermined feedback information to the sponsor, in which the feedback information includes at least one of the number of times the advertisement data is provided to the user, a number of times the user clicks on the advertisement data, a time period the user visits a web page of the sponsor, and a number of times the user visits the web page of the sponsor after the advertisement data is provided (see at least page 16, line 20- 21).*

Response to Arguments

22. Applicant's arguments filed 21 October 2009 have been fully considered but they are not persuasive.
23. Regarding the 112 1st paragraph rejection of claims 1, 8, 13, 14, 18 and 19. Examiner considered Applicant's remarks with respect to this rejection. In light of the amendments several arguments are moot and the rejections are either withdrawn or updated as noted above. Examiner notes that the references Applicant relies on to demonstrate support in the specification for various limitations are incorrect. Applicant refers to the 'original disclosure' which Examiner assumes is the originally filed specification as this is the only specification currently entered. If Applicant insists on further reliance on substitute specifications that are not entered in any future arguments, especially arguments regarding issues of new matter, Examiner will deem such responses non-responsive.
24. Regarding the prior art rejections Applicants noted that they "amended the claims to explicitly recite the various types of data within the presently claimed invention" (see page 18 of Applicant's remarks) to overcome the prior art rejections. As noted in the rejections above, descriptions of data in the claims that have no functional impact on the claimed method or system are considered non-functional descriptive material and do not affect the scope of the claim. Put another way, a claim to an invention that performs the same functions as a previously claimed

invention is not novel or non-obvious because the data collected or sent has different characteristics. Examiner is thoroughly familiar with the specification and is aware that the Nam reference does not teach several methods disclosed in the specification, however these methods are not present in the claims. The claim language is suffering from overly broad recitations and several instances of limitations which fail to limit the claim scope and overcome the Nam reference (see the rejection above for specific instances). The remaining arguments in which Applicant asserts whether or not Nam teaches various data content (see pages 19 and 20) fail to convince Examiner that Applicant's claim language is limited to an invention that is not obvious over the Nam and Cheung disclosures.

25. In response to Applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the predetermined event is then analyzed to determine its "type" (see page 18), "the 'effective period' is provided for keywords in advance" (page 18) and type determines the history data (page 19)) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
26. Applicant argues on pages 20-21 that Nam is an insufficient reference because Nam 'assumes' the interested field of the user rather than 'determine' the interested field of the user as claimed. Examiner points out that an assumption is a determination. This is a good example of the breadth of Applicant's claim language and why the broad claim language is preventing the narrow interpretation Applicant is seeking.
27. Applicant's argument on pages 21-22, Applicant merely changed the name of the counting feature in the claim and argued that the prior art references do not teach the 'request counter.' As noted in the rejection above, the references disclose the counting feature, albeit for different 'data.' Examiner is not convinced that performing an old and well known computation on data with a different label overcomes the art and results in a novel or non-obvious invention.

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- 28.** Examiner added a new 101 rejection. As a result this Office action cannot be made final. Applicant is also entitled to an interview if Applicant wishes to discuss meaningful claim amendments that will overcome the Nam/Cheung references.

Conclusion

29. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
31. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

32. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building
401 Dulany Street
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
7 January 2010

/Arthur Duran/
Primary Examiner, Art Unit 3622